

## **REMARKS**

Applicant expresses appreciation to the Examiner for consideration of the subject patent application. These remarks are in response to the Office Action mailed April 8, 2004. Claims 1-21 were originally presented. Claims 1-21 remain pending in the application. Claims 1-21 were rejected.

Claims 1-5 are rejected under 35 U.S.C. §103(a) as being obvious over Moor et al. (US Pat. No. 6,431,779) ("Moor"). Claims 1-6, 20 and 21 are rejected under 35 U.S.C. §103(a) as being obvious over Hatano et al. (US Pat. No. 5,741,028) ("Hatano"), in view of Hatano et al.'s listed prior art. Claims 7-18 are rejected under 35 U.S.C. §103(a) as being obvious over Hatano et al. in view of Hatano's prior art and further in view of Lee et al. (US Pat. No. 5,947,279) ("Lee"). Claim 19 is rejected under 35 U.S.C. §103(a) as being obvious over Hatano et al. in view of Hatano's prior art and Lee et al., and further in view of Shannon (U.S. Pat. No. 4,784,508) ("Shannon").

### **Claim Rejections - 35 U.S.C. § 103**

The following discussion shall be directed to the issues raised as pertinent to the independent claims of the application. It is recognized that the issues raised by the Examiner pertaining only to dependent claims are addressed by discussions regarding the independent claims, as they are in this case rendered moot if the independent claim(s) are found allowable. The dependent claims are narrower in scope than the independent claims from which they depend, and in the present circumstances are patentable if the independent claim(s) are patentable.

The Moor reference does not teach or suggest all of the elements of claims 1-5.

Specifically, the Moor reference does not teach an accordion-style, archival poly organizer accommodating 12" x 12" paper, but rather teaches a conventional student-oriented organizer, including a standard 3-ring binder. Accordingly, the Moor citation teaches away from making the organizer any size other than standard 3-ring binder size to accommodate 8 ½" x 11" paper.

The Hatano reference does not teach or suggest all of the elements of claims 1-21.

Specifically, the Hatano reference does not teach an accordion-style, archival poly organizer accommodating 12" x 12" scrapbooking paper, but rather teaches away from an organizer accommodating 12" x 12" paper. In the Hatano reference there is no teaching of the size of the sheets to be accommodated, and in light of this, one skilled in the art would assume a device in accordance with the Hatano reference accommodates standard size paper, not 12" x 12" scrapbooking paper.

The Applicant does not contend that poly organizers did not exist prior to the Applicant's invention, nor does the Applicant contend that expandable organizers did not exist prior to the Applicant's invention. However, the Applicant does assert that no one in the industry catering to the scrapbooking market had ever made an accordion-style, archival poly organizer that accommodated 12" x 12" scrapbooking paper prior to applicant's invention; and moreover that applicant's invention was not obvious. In support of this position the Applicant reminds the Examiner of the secondary indicia of non-obviousness which are its basis, as follows.

**I. There Was a Long-Felt Need in the Scrapbooking Industry for Invention.**

Even though 12” x 12” paper had existed for several years and was a standard paper size used by scrapbookers, there were no accordion-style, translucent poly organizers that would fit standard scrapbooking paper this size. “[W]hen evidence in the record fully supports a finding that others in the industry failed to solve the problem, then objective considerations ‘may. . . establish that an invention appearing to have been obvious in light of the prior art was not.’” *Alco Standard Corp. v. Tennessee Valley Authority*, 808 F. 2d 1490, 1500-01, 1 USPQ2d 1337, 1334-45 9Fed. Cir. 1986).

In the present case, Applicant submits that there was a long-felt need in the scrapbooking industry for a product like that of Applicant’s invention. Prior to the Applicant’s invention, scrapbookers were organizing their materials in organizers made from cardboard, cardstock and other opaque materials including boxes and folders that were intended for other purposes, and inaccurately fit the 12” x 12” scrapbooking paper. This is supported by the declarations of scrapbookers and scrapbooking experts in the industry (see Exhibit A). Accordingly, since there was a long-felt need for an organizer like that of the Applicant’s invention, and since no one else invented such an organizer before, there should be a finding that the Applicant’s claims are non-obvious.

**II. Applicant Experienced Commercial Success With the Introduction of Her Scrapbooking Organizer Into the Marketplace, And Others Immediately Copied the Organizer.**

Another factor to consider in determining the non-obviousness of a particular invention is whether the invention has experienced commercial success in the marketplace. In the present case, Applicant introduced her invention into the marketplace, and it experienced immediate

success. This is further evidenced by the fact that shortly after the Applicant introduced her new product, other manufacturers began marketing similar products that embodied the invention, specifically, an accordion-style, translucent poly organizers accommodating 12" x 12" paper (again, see declarations attached hereto in Exhibit A). Accordingly, since Applicant's invention experienced commercial success in the market place immediately after introduction and after many years of manufacturers' and customers' having all the relevant elements available to them (12" x 12" paper, accordion-style organizers, and polynomic resin materials) but having no product in accordance with the invention, such evidence of commercial success of the invention upon introduction further establishes non-obviousness.

## CONCLUSION

In light of the above, Applicant respectfully submits that pending claims 1-21 are non-obvious, and are in condition for allowance. Therefore, Applicant requests that the rejections be reconsidered and withdrawn, and that the claims be allowed and passed to issue. If any impediment to the allowance of these claims remains after entry of this Amendment which is amenable to resolution by telephone conference, the Examiner is strongly encouraged to call Clifton W. Thompson at (801) 566-6633 so that any such matter may be resolved as expeditiously as possible.

Check No. 204165, in the amount of \$490.00, is enclosed pursuant to 37 C.F.R. § 1.17(a)(3), for a 3 month extension of time pursuant to 37 C.F.R. § 1.136

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 20-0100.

DATED this 8<sup>th</sup> day of October, 2004.

Respectfully submitted,



Clifton W. Thompson  
Registration No. 36,947

THORPE NORTH & WESTERN, LLP  
Customer No. 20,551  
P.O. Box 1219  
Sandy, Utah 84091-1219  
Telephone: (801) 566-6633